



THE UNITED STATES PATENT AND TRADEMARK OFFICE

#23
v Butl

Applicant: Beach *et al.*

Art Unit: 2672

Serial No.: 09/181,402

Dkt. No.: RO998-106

Filed: 10/28/1998

Examiner: Chung, Daniel J.

Title: **METHOD AND APPARATUS FOR PRIORITY TRANSMISSION AND DISPLAY OF KEY AREAS OF IMAGE DATA**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

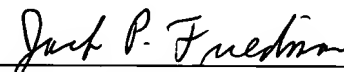
MAY 27 2004

Technology Center 2600

Request for Re-Instatement of Appeal Under 37 CFR §1.93(b)(2)

Applicants request Re-Instatement of the Appeal from the rejection of the Examiner dated May 16, 2003, in light of the Office Action mailed March 1, 2004. Submitted herewith is a Supplemental Appeal Brief which addresses the rejection of claims in the Office Action mailed March 1, 2004.

Respectfully submitted,



Jack P. Friedman
Attorney For Appellant
Registration No. 44,688

Dated: 05/21/2004

Schmeiser, Olsen & Watts
3 Lear Jet Lane - Suite 201
Latham, New York 12110
(518) 220-1850

09/181,402



AF/2672

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
R0998-106

In Re Application Of: Beach et al.

#23

Butt

Serial No.
09/181,402

Filing Date
10/28/1998

Examiner
Chung, Daniel J.

Group Art Unit
2672

Title: **METHOD AND APPARATUS FOR PRIORITY TRANSMISSION AND DISPLAY OF KEY AREAS OF IMAGE DATA**

RECEIVED

TO THE COMMISSIONER FOR PATENTS:

MAY 27 2004

Technology Center 2600

Transmitted herewith is:

Request for Re-Instatement of Appeal
Supplemental Brief of Appellants (37 pages) (3 sets)

in the above identified application.

- ☒ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. 09-0465(IBM) as described below.
- ☐ Charge the amount of _____
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.

Jack P. Friedman
Signature

Dated: 5/21/2004

Jack P. Friedman
Reg. No. 44,688
Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, NY 12110
(518) 220-1850

I certify that this document and fee is being deposited on ~~5/21/04~~ 5/21/04 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Kim Dwileski
Signature of Person Mailing Correspondence

Kim Dwileski

Typed or Printed Name of Person Mailing Correspondence

cc:



#24

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Beach *et al.*

Art Unit: 2672

Serial No.: 09/181,402

Dkt. No.: RO998-106

Filed: 10/28/1998

Examiner: Chung, Daniel J.

Title: **METHOD AND APPARATUS FOR PRIORITY TRANSMISSION AND DISPLAY OF KEY AREAS OF IMAGE DATA**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

MAY 27 2004

Technology Center 2600

SUPPLEMENTAL BRIEF OF APPELLANTS

This Supplemental Appeal Brief, pursuant to the Office Action mailed March 1, 2004, is an appeal resulting from the rejection of the Examiner dated May 16, 2003 and supplements the prior Appeal Brief filed September 16, 2003. The present Supplemental Appeal Brief supports Appellants request to reinstate the appeal and addresses the rejection of claims in the Office Action mailed March 1, 2004.

REAL PARTY IN INTEREST

International Business Machines, Inc. is the real party in interest.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-49 are currently pending.

STATUS OF AMENDMENTS

There are no After-Final Amendments which have not been entered.

SUMMARY OF INVENTION

The present invention discloses an apparatus, an associated program product, and an associated method. The apparatus comprises a transmitting computer comprising at least one processor and a memory coupled to the at least one processor. See FIG. 1 and specification, page 10, lines 21-26. A prioritized graphics file resides in the memory, the prioritized graphics file defining higher priority image transmission portions and lower priority image transmission portions that have been selected and assigned priorities such that when the prioritized graphics file is transferred across a network, the higher priority image transmission portions of the prioritized graphics file are transmitted before the lower priority image transmission portions of the prioritized graphics file. See specification, page 24, lines 1-6; page 14, lines 16-25.

A receiving computer receives image transmission portions of the prioritized graphics file. The receiving computer may comprise an image interpreter and an image viewer residing on the receiving computer, the image interpreter translating the received image transmission portions of the prioritized graphics file into image data, such that the image viewer can display the higher priority image transmission portions of the prioritized graphics file before displaying the lower priority image transmission portions of the prioritized graphics file. See specification,

page 17, lines 17-28.

An image prioritization editor may reside in the memory, the image prioritization editor allowing at least one image transmission portion of the prioritized graphics file to be selected and assigned at least one priority. See specification, page 14, lines 16-23.

The image interpreter may save the prioritized graphics file in the prioritized graphics file. The prioritized graphics file format may comprise joint picture experts group format, graphics interchange format, or bitmap format. The prioritized graphics file format may comprises a plurality of image transmission portions of the prioritized graphics file, each image transmission portion corresponding to the at least one priority. See specification, page 15, lines 4-21.

A simulation browser may simulate transmission and reception of the prioritized graphics file, the simulation browser adding a delay between image transmission portions of the prioritized graphics file. See specification, page 15, line 27 - page 16, line 6.

Signal bearing media bearing the image interpreter may comprise transmission media and may comprise recordable media. See specification, page 14, line 22 - page 13, line 2.

ISSUES

1. Whether claims 1- 6, 8-12, 14-21, 23-29, and 31-49 are unpatentable under 35 U.S.C. §103(a) over Scorse et al. (5,426,513) in view of Cash et al (5,481,312).

2. Whether claims 7, 13, 22, 30, and 36 are unpatentable under 35 U.S.C. §103(a) over Scorse et al. (5,426,513) in view of Cash et al (5,481,312), and further in view of Weber (5,477,445).

GROUPING OF CLAIMS

The claims are grouped as shown in Table 1:

Table 1

Group	Claims	Do Claims of Group Stand or Fall Together?
1	1, 3, 5, 9, 11, 14-16, 18, 20, 24-26, 28, 41-46	Yes
2	2, 8, 17, 23	Yes
3	4, 10, 19, 27, 6, 12, 21, 29	Yes
4	31-35, 37-40, 47-49	Yes
5	7, 13, 22, 30	Yes
6	36	Yes

The claims of Group 2 do not stand and fall together with the claims of Group 1, because the claims of Group 2 include the following issues not present in any of the claims of Group 1: “the image viewer can display the higher priority image transmission portions of the prioritized graphics file before displaying the lower priority image transmission portions of the prioritized graphics file”.

The claims of Group 3 do not stand and fall together with the claims of Groups 1-2, because the claims of Group 3 include the following issues not present in any of the claims of Group 1-2: “the image interpreter saving the prioritized graphics file in a prioritized graphics file format”.

The claims of Group 4 do not stand and fall together with the claims of Groups 1-3, because the claims of Group 4 are method claims and none of the claims in Group 1-3 are

method claims.

The claims of Group 5 do not stand and fall together with the claims of Groups 1-4, because the claims of Group 5 include the following issues not present in any of the claims of Group 1-4: “the simulation browser adding a delay between image transmission portions of the prioritized graphics file”.

The claims of Group 6 do not stand and fall together with the claims of Groups 1-5, because the claims of Group 6 are method claims reciting the active method steps of “waiting a delay” and “repeating steps A through E until the entire prioritized graphics file has been transmitted and received.”, and none of the claims in Group 1-3 are method claims reciting said active method steps.

ARGUMENT

Issue 1

CLAIMS 1- 6, 8-12, 14-21, 23-29, AND 31-49 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(A) OVER SCORSE ET AL. (5,426,513) IN VIEW OF CASH ET AL (5,481,312).

The Examiner rejected claims 1- 6, 8-12, 14-21, 23-29, and 4as allegedly being unpatentable under 35 U.S.C. §103(a) over Scorse et al. (5,426,513) in view of Cash et al (5,481,312).

Claim 1

Appellants contend that claim 1 is not unpatentable over Scorse in view of Cash, because Scorse in view of Cash does not teach or suggest every feature of claim 1. For example, Scorse in view of Cash does not teach or suggest the feature: “a prioritized graphics file residing in the memory, the prioritized graphics file defining higher priority image transmission portions and lower priority image transmission portions that have been selected and assigned priorities such that when the prioritized graphics file is transferred across a network, the higher priority image transmission portions of the prioritized graphics file are transmitted before the lower priority image transmission portions of the prioritized graphics file.”

The Examiner admits that “Scorse et al does not explicitly disclose that a single prioritized graphics file residing in the memory, which contains higher priority image transmission portions and lower priority image transmission portions. ”.

The Examiner alleges that “Cash et al discloses that the method of transmitting a

prioritized video bitstream ["a prioritized graphics file"], which stored in hard disc 115, 202 ["memory"], including a plurality of high priority segments ["higher priority image transmission portions"] and low priority segments ["lower priority image transmission portions"], thereby generating the high priority segments first on monitor in client. (See Fig 1, Fig 2, Fig 4, Abstract, col I line 52-62)"

The Examiner argues: "It would have obvious to one having ordinary skill in the art at the time of Applicant's invention to incorporate the teaching of Cash et al into the teaching of Scorse et al, because they both relate to method of transmitting image/graphic data in network, and the teachings/suggestions in Scorse (See col 6 line 17-19) regarding of "transmission time is kept to a minimum and the information of most importance is transmitted with priority", would provide the motivation to have prioritized image file, in order to retrieve/render more important/significant information with effective and easy manner."

In response, Appellants contend that the Examiner's argument for modifying Scorse by Cash's alleged teaching of storing higher and lower priority image transmission portions of a prioritized graphics file in the memory is not persuasive. Scorse discloses that the higher and lower priority image transmission portions of a visual image are selected by the user (also called "operator" by Scorse) after the user is presented with a visual image. In particular, the user sequentially: selects a first portion of the image, transmits the first portion, selects a second portion of the image, transmits the second portion, etc. See Scorse, col. 5, 63 - col. 6, line 33. The aforementioned role of the user in sequentially prioritizing and transmitting the portions of the image to be transmitted is the essence of Scorse's invention and cannot be eliminated. See Scorse, col, 2, lines 35-41 ("It is yet another object of the present invention to provide a novel

video image system and method in which the resolution of the image to be transmitted may be controlled by the operator of the video system in accordance with the operator's interest in the contents of the video image"). See also Scorse, col. 2, lines 42-45 ("It is still a further object of the present invention to provide a novel system and method of video image transmission whereby the portion of the image of most interest to the user is transmitted first"). Therefore, Appellants contend that the higher and lower priority image transmission portions of the visual image in Scorse do not exist until selected by the user.

The next question is whether there is motivation to generate a file and store the file in memory, wherein the file would contain the higher and lower priority image transmission portions of the visual image. As explained *supra*, this file would have to be generated after the user selects the higher and lower priority image transmission portions. Appellants argue that no such motivation exists. In fact, generation of such a file would serve no purpose, because Scorse's disclosed method of sequentially selecting and transmitting the portions of the image in their order of priority is extremely efficient. See Scorse, col. 6, lines 17-19 ("In this way, transmission time is kept to a minimum and the information of most importance is transmitted with priority"). In fact, the Examiner's suggestion to generate such a file and store the file in memory would actually delay transmission of the higher priority portions by preventing the high priority portions from being transmitted until the lower priority portions have been selected and stored in memory along with the higher priority portions in such a file. Therefore, generation of such a file would in fact be contrary to Scorse's technique of transmitting the higher priority immediately after they are selected by the user. Accordingly, it would not be obvious to a person of ordinary skill in the art to generate such a file. Therefore, the Examiner's argument for

modifying Scorse by the teaching of Cash is not persuasive.

Based on the preceding arguments, Appellants contend that claim 1 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash. Accordingly, Appellants argue that the rejection of claim 1 is improper and should be reversed.

Claim 2

Since claim 2 depends from claim 1, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claim 2 is not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants contend that Scorse in view of Cash does not disclose “the receiving computer comprising an image interpreter and an image viewer residing on the receiving computer, the image interpreter translating the received image transmission portions of the prioritized graphics file into image data, such that **the image viewer can display the higher priority image transmission portions of the prioritized graphics file before displaying the lower priority image transmission portions of the prioritized graphics file**” (emphasis added).

The Examiner argues: “Regarding claim 2, refer to the discussion for the claim 1 hereinabove, Cash et al further discloses that a receiving computer [230] receiving image transmission portions of the prioritized graphics file [a prioritized video bitstream], the receiving computer comprising an image interpreter [i.e. 221,223,224] and an image viewer [225] residing on the receiving computer, the image interpreter translating the received image transmission portions of the prioritized graphics file into image data, such that the image viewer can display

the higher priority image transmission portions of the prioritized graphics file before displaying the lower priority image transmission portions of the prioritized graphics file. (See Fig 2, Fig 4, col 1 line 51-62)”.

In response, Appellants content that col, 1, lines 51-62 of Cash does not support the Examiner’s allegation that Cash discloses “display[ing] the higher priority image transmission portions of the prioritized graphics file before displaying the lower priority image transmission portions of the prioritized graphics file.” In fact, Cash, col. 2, lines 57-62 recite: “When the low priority partition is received at the receiver location, its segments are interleaved with each generated high priority segment, in real time to recreate the video bitstream”. The preceding quote from Cash does teach or suggest that the higher priority image transmission portions are displayed before the lower priority image transmission portions are displayed. In fact, the meaning of the preceding quote from Cash may be understood from Cash, col. 3, lines 34-39 which recites: “Processor 221 interleaves the high priority data received from disc 222 with the low priority data received by network interface 223 and then sends the interleaved data to decoder 224. The output of decoder 224 is the requested video segment which is then displayed on the client monitor 225.” Thus, the preceding quote makes it clear that it is the interleaved data (i.e., high and low priority data interleaved together) that is ultimately displayed. This demonstrates that Cash does not disclose displaying the higher priority image transmission portions of the prioritized graphics file before displaying the lower priority image transmission portions of the prioritized graphics file, as alleged by the Examiner.

Accordingly, Appellants contend that claim 2 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claim 3

Since claim 3 depends from claim 1, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claim 3 is not unpatentable under 35 U.S.C. §103(a).

Claim 4

Since claim 4 depends from claim 1, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claim 4 is not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants contend that Scorse in view of Cash does not disclose “further comprising an image interpreter, the image interpreter saving the prioritized graphics file in a prioritized graphics file format”.

The Examiner argues: “Regarding claim 4, refer to the discussion for the claim 1 hereinabove, Cash et al further discloses that the image interpreter saving the prioritized graphics file in a prioritized graphics file format [408]. (See Fig 2-4)”.

In response, Appellants contend that step 408 in FIG. 4 refers only to high priority data and not to the prioritized graphics file which is claimed in claim 4 to contain both higher and lower priority data. See Cash, col. 6, lines 36-37 (“In step 408, client 220 stores the high priority data.”). Thus, the Examiner’s argument in relation to claim 8 is not persuasive.

Accordingly, Appellants contend that claim 4 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claim 5

Since claim 5 depends from claim 1, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claim 5 is not unpatentable under 35 U.S.C. §103(a).

Claim 6

Since claim 6 depends from claim 1, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claim 6 is not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants contend that Scorse in view of Cash does not disclose “wherein the prioritized graphics file format comprises a plurality of image transmission portions of the prioritized graphics file, each image transmission portion corresponding to the at least one priority”.

The Examiner argues “Regarding claim 6, refer to the discussion for the claims 1 and 5 hereinabove, Scorse et al discloses that the prioritized graphics file format comprises a plurality of image transmission portions of the prioritized graphics file, each image transmission portion corresponding to the at least one priority. (See Fig 1, Fig 3D, col 5 line 6-24, col 5 line 63-col 6 line 33)”.

In response, Appellants contend that the preceding argument by the Examiner is inconsistent with the Examiner’s assertion that “Scorse et al does not explicitly disclose that a single prioritized graphics file residing in the memory, which contains higher priority image transmission portions and lower priority image transmission portions. ” In essence, the

Examiner's argument in relation to claim 6 alleges that Scorse discloses the claimed prioritized graphics file, even though the Examiner elsewhere admits that Scorse does not disclose the claimed prioritized graphics file.

Accordingly, Appellants contend that claim 6 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claim 8

The Examiner alleges: "Regarding claim 8, claim 8 is similar in scope to the combination of claims 1 and 2, and thus the rejections to claims 1 and 2 hereinabove are also applicable to claim 8."

In response, Appellants refer to Appellants' arguments presented *supra* in relation to claims 1 and 2.

Accordingly, Appellants contend that claim 8 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claims 9-12

Since claims 9-12 depend from claim 8, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 9-12 are not unpatentable under 35 U.S.C. §103(a).

In addition, the Examiner alleges: "Regarding claims 9-12, claims 9-12 are respectively equivalent to claims 3-6, and thus the rejections to claims 3-6 hereinabove are also respectively

applicable to claims 9-12, but applied in view of the rejections to base claim 8.”

In response, Appellants refer to Appellants’ arguments presented *supra* in relation to claims 3-6, applied in view of claim 8.

Accordingly, Appellants contend that claims 9-12 are not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claims 14-16

The Examiner alleges: “Regarding claims 14-16, claims 14-16 are similar in scope to claim 1, and thus the rejection to claim 1 hereinabove is also applicable to claims 14-16. In addition, Cash et al discloses that signal bearing media bearing the image interpreter wherein the signal bearing media comprises transmission media or recordable media. (See Fig 2).”

In response, Appellants refer to Appellants’ arguments presented *supra* in relation to claim 1.

Accordingly, Appellants contend that claims 14-16 are not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claims 17-21

Since claims 17-21 depend from claim 14, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 17-21 are not unpatentable under 35 U.S.C. §103(a).

In addition, the Examiner alleges: “Regarding claims 17-21, claims 17-21 are respectively equivalent to claims 2-6 and thus the rejections to claims 2-6 hereinabove are also respectively

applicable to claims 17-21, but applied in view of the rejections to base claim 14.”

In response, Appellants refer to Appellants’ arguments presented *supra* in relation to claims 2-6, applied in view of claim 14.

Accordingly, Appellants contend that claims 17-21 are not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claim 23

The Examiner alleges: “Regarding claim 23, claim 23 is the corresponding program product of claims 14 and 17. Thus, the rejections to claims 14 and 17 hereinabove are also applicable to claim 23”.

In response, Appellants refer to Appellants’ arguments presented *supra* in relation to claims 14 and 17.

Accordingly, Appellants contend that claim 23 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claims 24-29

Since claims 24-29 depend from claim 23, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 24-29 are not unpatentable under 35 U.S.C. §103(a).

In addition, the Examiner alleges: “Regarding claims 24-29, claims 24-29 are respectively equivalent to claims 15-21 and thus the rejections to claims 15-21 hereinabove are also respectively applicable to claims 24-30, but applied in view of the rejections to base claim 23”.

In response, Appellants refer to Appellants' arguments presented *supra* in relation to claims 15-22, applied in view of claim 23.

Accordingly, Appellants contend that claims 24-29 are not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claim 31

The Examiner alleges: "Regarding claim 31, claim 31 is similar in scope to claim 1, and thus, the rejection to claim 1 hereinabove is also applicable to claim 31".

In response, Appellants refer to Appellants' arguments presented *supra* in relation to claim 1.

In addition, Appellants maintain that the Examiner's basis for rejecting claim 1 is not sufficient for rejecting claim 31, because claim 1 claims an apparatus whereas claim 31 claims a method.

Accordingly, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 31: "**selecting** at least one image transmission portion of the graphics file".

Appellants also contend that the Examiner has not presented any arguments directed to the following active method step of claim 31: "**assigning** a priority to the selected at least one image transmission portion to create a prioritized graphics file".

Appellants further contend that the Examiner has not presented any arguments directed to the following active method step of claim 31: "**transmitting** the prioritized graphics file across a network such that higher priority image transmission portions are transmitted before lower

priority image transmission portions”.

By not presenting any arguments directed to the active method steps of step 31, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 31.

Accordingly, Appellants contend that claim 31 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claim 32-34

Since claims 32-34 depends from claim 31, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 32-34 are not unpatentable under 35 U.S.C. §103(a).

In addition, the Examiner alleges: “Regarding claims 32-34, claims 32-34 are respectively equivalent to claims 4-6, and thus the rejections to claims 4-6 hereinabove are also respectively applicable to claims 32-34, but applied in view of the rejections to base claim 31”.

In response, Appellants refer to Appellants’ arguments presented *supra* in relation to claims 4-6, applied in view of claim 31.

In addition, Appellants maintain that the Examiner’s basis for rejecting claims 4-6 is not sufficient for rejecting claims 32-34, because claims 4-6 claim an apparatus whereas claims 32-34 claims a method.

Accordingly, Appellants contend that claims 32-34 are not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash, applied in view of claim 31.

Claim 35 and 38-40

The Examiner alleges: “Regarding claim 35 and 38-40, claim 35 and 38-40 are similar in scope to claims 8, 13 and 10-12. Thus, the rejections to claims 8, 13 and 10-12 hereinabove are also applicable to claim 35 and 38-40”.

In response, Appellants refer to Appellants’ arguments presented *supra* in relation to claims 8, 13 and 10-12.

In addition, Appellants maintain that the Examiner’s basis for rejecting claims 8, 13 and 10-12 is not sufficient for rejecting claim 35 and 38-40, because claims 8, 13 and 10-12 claim an apparatus whereas claim 35 and 38-40 claim a method.

Accordingly, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 35: “**selecting** [by the transmitting computer] at least one image transmission portion of the graphics file”.

Also, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 35: “**assigning** [by the transmitting computer] a priority to the selected at least one image transmission portion to create a prioritized graphics file”.

In addition, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 35: “**determining** [by the transmitting computer] the location of the image transmission portion of the prioritized graphics file”.

Additionally, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 35: “**transmitting** [by the transmitting computer] the prioritized graphics file across a network such that higher priority image transmission portions are transmitted before lower priority image transmission portions”.

Also, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 35: “**receiving** [by the receiving computer] a image transmission portion of the prioritized graphics file”.

Also, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 35: “**translating** [by the receiving computer] the image transmission portion of the prioritized graphics file into image data”.

Also, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 35: “**determining** [by the receiving computer] the location of the image transmission portion of the prioritized graphics file”.

Also, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 35: “**transferring** [by the receiving computer] the image data and the location to an image viewer such that the image viewer can display the image transmission portion of the prioritized graphics file at the location”.

By not presenting any arguments directed to the active method steps of step 35, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 35.

Accordingly, Appellants contend that claims 35 and 38-40 are not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claim 37

Since claim 37 depends from claim 35, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claim 37 is not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants contend that Scorse in view of Cash does not disclose “wherein the step of translating the image transmission portion of the prioritized graphics file into image data further comprises the step of decompressing the image transmission portion of the prioritized graphics file”.

The Examiner argues: “Regarding claim 37, Scorse et al discloses that the step of translating the portion of the image file into image data further comprises that step of decompressing the portion of the image file. (See Fig 3-6)”.

In response, Appellants contend that the preceding argument by the Examiner is inconsistent with the Examiner’s assertion that “Scorse et al does not explicitly disclose that a single prioritized graphics file residing in the memory, which contains higher priority image transmission portions and lower priority image transmission portions.” In essence, the Examiner’s argument in relation to claim 37 alleges that Scorse discloses the claimed prioritized graphics file, even though the Examiner elsewhere admits that Scorse does not disclose the claimed prioritized graphics file.

Accordingly, Appellants contend that claim 37 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Claims 41-49

Since claims 41-43, 44-46, and 47-49 depend from claim 1, claim 14, and claim 31, respectively, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 41-49 are not unpatentable under 35 U.S.C. §103(a).

In addition, the Examiner argues: “Regarding claims 41-49, claims 41-49 are similar in

scope to the claim 5, and thus the rejection to claim 5 hereinabove is also applicable to claims 41-49.”

In response, Appellants refer to Appellants’ arguments presented *supra* in relation to claim 5.

In addition, Appellants maintain that the Examiner’s basis for rejecting claim 5 is not sufficient for rejecting claims 44-46, because claim 5 claims an apparatus whereas claims 44-46 claim a program product.

In addition, Appellants maintain that the Examiner’s basis for rejecting claim 5 is not sufficient for rejecting claims 47-49, because claim 5 claims an apparatus whereas claims 47-49 claim a method.

Accordingly, Appellants contend that claims 41-49 are not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash.

Issue 2

CLAIMS 7, 13, 22, 30, AND 36 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(A) OVER SCORSE ET AL. (5,426,513) IN VIEW OF CASH ET AL (5,481,312), AND FURTHER IN VIEW OF WEBER (5,477,445).

The Examiner rejected Whether claims 7, 13, 22, 30, and 36 as allegedly being unpatentable under 35 U.S.C. §103(a) over Scorse et al. (5,426,513) in view of Cash et al (5,481,312), and further in view of Weber (5,477,445).

Claim 7

Since claim 7 depends from claim 1, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claim 7 is not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants contend that Scorse in view of Cash in view of Weber does not disclose the feature: “the simulation browser adding a delay between image transmission portions of the prioritized graphics file”.

The Examiner argues that Weber discloses the preceding feature of claim 7 in the Abstract and col. 1, line 17-col. 2, line 29.

In response, Appellants contend that the Abstract and col. 1, line 17-col. 2, line 29 of Weber do not teach or suggest the preceding feature of claim 7.

Moreover, the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Scorse by the teaching of Weber in relation to claim 7. In particular, established case law requires that the prior art must contain some

suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention.”)). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 (“The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification.”)). Appellant maintains that the Examiner has not made any showing of where the prior art suggests incorporation of “the simulation browser adding a delay between image transmission portions of the prioritized graphics file” into the invention of Scorse. Thus, the Examiner has created a reason for the combination that the Examiner has not supported by the cited prior art. By not citing any suggestion or incentive in the prior art for incorporating the preceding feature of claim 7 into the invention of Scorse, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 7.

Accordingly, Appellants contend that claim 7 is not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash and further in view of Weber.

Claims 13, 22, 30, and 36

Since claims 13, 22, 30, and 36 respectively depend from claims 8, 14, 23, and 35, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 13, 22, 30, and 36 are not unpatentable under 35 U.S.C. §103(a).

In addition, the Examiner alleges: “Regarding claims 13,22,30 and 36, claims 13,22,30 and 36 are similar in scope to the combination of claims 1 and 7, and thus the rejections to claims 1 and 7 hereinabove are also applicable to claims 13, 22, 30 and 36.”.

In response, Appellants refer to Appellants’ arguments presented *supra* in relation to claims 1 and 7.

In addition, Appellants maintain that the Examiner’s basis for rejecting claims 1 and 7 is not sufficient for rejecting claim 36, because claims 1 and 7 claim an apparatus whereas claim 36 claims a method.

Accordingly, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 36: “**simulating** transmission and reception of a image transmission portion of the prioritized graphics file”.

Also, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 36: “**translating** the image transmission portion of the prioritized graphics file into image data”.

In addition, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 36: “**determining** the location of the image transmission portion of the prioritized graphics file”.

Additionally, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 36: “**transferring** the image data and the location to an image viewer such that the image viewer can display the image transmission portion of the prioritized graphics file at the location”.

Also, Appellants contend that the Examiner has not presented any arguments directed to

the following active method step of claim 36: “**waiting** a delay”.

Also, Appellants contend that the Examiner has not presented any arguments directed to the following active method step of claim 36: “**repeating** steps A through E until the entire prioritized graphics file has been transmitted and received”.

Appellants further note that the “repeating” step of claim 36 is specific to the method of claim 36 and is totally outside the scope of claims 1 and 7.

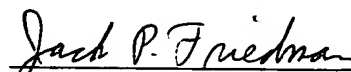
By not presenting any arguments directed to the active method steps of step 36, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 36.

Accordingly, Appellants contend that claims 13, 22, 30, and 36 are not unpatentable under 35 U.S.C. §103(a) over Scorse in view of Cash and further in view of Weber.

SUMMARY

In summary, Applicants respectfully request reversal of the rejection of claims 1-49 under 35 U.S.C. §103(a).

Respectfully submitted,



Jack P. Friedman
Attorney For Appellant
Registration No. 44,688

Dated: 05/21/2004

Schmeiser, Olsen & Watts
3 Lear Jet Lane - Suite 201
Latham, New York 12110
(518) 220-1850



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Beach *et al.*

Art Unit: 2672

Serial No.: 09/181,402

Dkt. No.: RO998-106

Filed: 10/28/1998

Examiner: Chung, Daniel J.

Title: **METHOD AND APPARATUS FOR PRIORITY TRANSMISSION AND DISPLAY OF KEY AREAS OF IMAGE DATA**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPENDIX - CLAIMS ON APPEAL

1. An apparatus comprising a transmitting computer comprising:
 - at least one processor;
 - a memory coupled to the at least one processor; and
 - a prioritized graphics file residing in the memory, the prioritized graphics file defining higher priority image transmission portions and lower priority image transmission portions that have been selected and assigned priorities such that when the prioritized graphics file is transferred across a network, the higher priority image transmission portions of the prioritized graphics file are transmitted before the lower priority image transmission portions of the prioritized graphics file.
2. The apparatus of claim 1 further comprising a receiving computer receiving image transmission portions of the prioritized graphics file, the receiving computer comprising an

image interpreter and an image viewer residing on the receiving computer, the image interpreter translating the received image transmission portions of the prioritized graphics file into image data, such that the image viewer can display the higher priority image transmission portions of the prioritized graphics file before displaying the lower priority image transmission portions of the prioritized graphics file.

3. The apparatus of claim 1 further comprising an image prioritization editor residing in the memory, the image prioritization editor allowing at least one image transmission portion of the prioritized graphics file to be selected and assigned at least one priority.
4. The apparatus of claim 3 further comprising an image interpreter, the image interpreter saving the prioritized graphics file in a prioritized graphics file format.
5. The apparatus of claim 4 wherein the prioritized graphics file format comprises joint picture experts group format, graphics interchange format, or bitmap format.
6. The apparatus of claim 4 wherein the prioritized graphics file format comprises a plurality of image transmission portions of the prioritized graphics file, each image transmission portion corresponding to the at least one priority.
7. The apparatus of claim 1 wherein the apparatus further comprises a simulation browser residing in the memory, the simulation browser simulating transmission and reception of the

prioritized graphics file, the simulation browser adding a delay between image transmission portions of the prioritized graphics file.

8. An apparatus comprising:

a transmitting computer comprising:

- a) at least one processor;
- b) a memory coupled to the at least one processor;
- b) a prioritized graphics file residing in the memory, the prioritized graphics

file defining higher priority image transmission portions and lower priority image transmission portions that have been selected and assigned priorities such that when the prioritized graphics file is transferred across a network, the higher priority image transmission portions of the prioritized graphics file are transmitted before the lower priority image transmission portions of the prioritized graphics file; and

a receiving computer receiving the prioritized graphics file as received data from the transmitting computer, the receiving computer including:

- a) at least one processor;
- b) a memory coupled to the at least one processor;
- c) an image viewer residing in the memory;
- d) an image interpreter residing in the memory and cooperating with the

image viewer to allow the image viewer to display received images, the image viewer translating the received data into image data to allow the image viewer to display the image data corresponding to the higher priority image transmission portions of the prioritized graphics file

before displaying the image data corresponding to the lower priority image transmission portions of the prioritized graphics file.

9. The apparatus of claim 8 wherein the transmitting computer further comprises an image prioritization editor residing in the memory, the image prioritization editor allowing at least one image transmission portion of the prioritized graphics file to be selected and assigned at least one priority.

10. The apparatus of claim 9 wherein the transmitting computer further comprises an image interpreter, the image interpreter saving the prioritized graphics file in a prioritized graphics file format.

11. The apparatus of claim 10 wherein the prioritized graphics file format comprises joint picture experts group format, graphics interchange format, or bitmap format.

12. The apparatus of claim 10 wherein the prioritized graphics file format comprises a plurality of image transmission portions of the prioritized graphics file, each image transmission portion corresponding to the at least one priority.

13. The apparatus of claim 8 wherein the transmitting computer further comprises a simulation browser residing in the memory, the simulation browser simulating transmission and reception of the prioritized graphics file, the simulation browser adding a delay between image transmission

portions of the prioritized graphics file.

14. A program product comprising:

an image interpreter for creating a prioritized transmission graphics file, the prioritized transmission graphics file defining higher priority image transmission portions and lower priority image transmission portions that have been selected and assigned priorities such that when the prioritized transmission graphics file is transferred across a network, the higher priority image transmission portions of the prioritized transmission graphics file are transmitted before the lower priority image transmission portions of the prioritized transmission graphics file; and
signal bearing media bearing the image interpreter.

15. The program product of claim 14 wherein the signal bearing media comprises transmission media.

16. The program product of claim 14 wherein the signal bearing media comprises recordable media.

17. The program product of claim 14 wherein the image interpreter can translate received image reception portions of a prioritized reception graphics file into image data such that an image viewer can display the higher priority image reception portions of the prioritized reception graphics file before displaying the lower priority image reception portions of the prioritized

reception graphics file.

18. The program product of claim 14 further comprising an image prioritization editor, the image prioritization editor allowing at least one image transmission portion of the prioritized transmission graphics file to be selected and assigned at least one priority.

19. The program product of claim 18 wherein the image interpreter can save the prioritized transmission graphics file in a prioritized transmission graphics file format.

20. The program product of claim 19 wherein the prioritized transmission graphics file format comprises joint picture experts group format, graphics interchange format, or bitmap format.

21. The program product of claim 19 wherein the prioritized transmission graphics file format comprises a plurality of image transmission portions of the prioritized transmission graphics file, each image transmission portion corresponding to the at least one priority.

22. The program product of claim 14 wherein the program product further comprises a simulation browser for simulating transmission and reception of the prioritized transmission graphics file, the simulation browser adding a delay between image transmission portions of the prioritized transmission graphics file.

23. A program product comprising:

an image interpreter for creating a prioritized transmission graphics file, the prioritized transmission graphics file defining higher priority image transmission portions and lower priority image transmission portions that have been selected and assigned priorities such that when the prioritized transmission graphics file is transferred across a network, the higher priority image transmission portions of the prioritized transmission graphics file are transmitted before the lower priority image transmission portions of the prioritized transmission graphics file, the image interpreter also for translating received image reception portions of a prioritized reception graphics file into image data such that an image viewer can display the higher priority image reception portions of the prioritized reception graphics file before displaying the lower priority image reception portions of the prioritized reception graphics file; and
signal bearing media bearing the image interpreter.

24. The program product of claim 23 wherein the signal bearing media comprises transmission media.

25. The program product of claim 23 wherein the signal bearing media comprises recordable media.

26. The program product of claim 23 further comprising an image prioritization editor for allowing at least one image transmission portion of the prioritized transmission graphics file to be selected and assigned at least one priority.

27. The program product of claim 26 wherein image interpreter can save the prioritized transmission graphics file in a prioritized transmission graphics file format.
28. The program product of claim 27 wherein the prioritized transmission graphics file format comprises joint picture experts group format, graphics interchange format, or bitmap format.
29. The program product of claim 27 wherein the prioritized transmission graphics file format comprises a plurality of image transmission portions of the prioritized transmission graphics file, each image transmission portion corresponding to the at least one priority.
30. The program product of claim 23 further comprising a simulation browser for simulating transmission and reception of the prioritized transmission graphics file, the simulation browser adding a delay between image transmission portions of the prioritized transmission graphics file.
31. A method for transmitting a graphics file from a transmitting computer, the method comprising the steps of:
- a) selecting at least one image transmission portion of the graphics file;
 - b) assigning a priority to the selected at least one image transmission portion to create a prioritized graphics file; and
 - c) transmitting the prioritized graphics file across a network such that higher priority image transmission portions are transmitted before lower priority image transmission portions.

32. The method of claim 31 further comprising the step of saving the prioritized graphics file in a prioritized graphics file format.

33. The method of claim 32 wherein the prioritized graphics file format comprises joint picture experts group format, graphics interchange format, or bitmap format.

34. The method of claim 32 wherein the prioritized graphics file format comprises a plurality of image transmission portions of the prioritized graphics file, each image transmission portion corresponding to the at least one priority.

35. A method for transmitting a graphics file from a transmitting computer and receiving the graphics file on a receiving computer, the method comprising the steps of:

- a) performing the following steps on the transmitting computer:
 - i) selecting at least one image transmission portion of the graphics file;
 - ii) assigning a priority to the selected at least one image transmission portion to create a prioritized graphics file; and
 - iii) transmitting the prioritized graphics file across a network such that higher priority image transmission portions are transmitted before lower priority image transmission portions;
- b) performing the following steps on the receiving computer:
 - i) receiving a image transmission portion of the prioritized graphics file;
 - ii) translating the image transmission portion of the prioritized graphics file

- into image data;
- iii) determining the location of the image transmission portion of the prioritized graphics file; and
- iv) transferring the image data and the location to an image viewer such that the image viewer can display the image transmission portion of the prioritized graphics file at the location.

36. The method of claim 35 wherein the step of transmitting the prioritized graphics file across a network such that higher priority image transmission portions are transmitted before lower priority image transmission portions further comprises the following steps:

- A) simulating transmission and reception of a image transmission portion of the prioritized graphics file;
- B) translating the image transmission portion of the prioritized graphics file into image data;
- C) determining the location of the image transmission portion of the prioritized graphics file;
- D) transferring the image data and the location to an image viewer such that the image viewer can display the image transmission portion of the prioritized graphics file at the location
- E) waiting a delay; and
- F) repeating steps A through E until the entire prioritized graphics file has been transmitted and received.

G)

37. The method of claim 35 wherein the step of translating the image transmission portion of the prioritized graphics file into image data further comprises the step of decompressing the image transmission portion of the prioritized graphics file.

38. The method of claim 35 further comprising the following step that is performed on the transmitting computer:

iv) saving the prioritized graphics file in a prioritized graphics file format.

39. The method of claim 38 wherein the prioritized graphics file format comprises joint picture experts group format, graphics interchange format, or bitmap format.

40. The method of claim 38 wherein the prioritized graphics file format comprises a plurality of image transmission portions of the prioritized graphics file, each image transmission portion corresponding to the at least one priority.

41. The apparatus of claim 1 wherein the prioritized graphics file comprises a joint picture experts group file.

42. The apparatus of claim 1 wherein the prioritized graphics file comprises a graphics interchange format file.

43. The apparatus of claim 1 wherein the prioritized graphics file comprises a bitmap file.
44. The program product of claim 14 wherein the prioritized graphics file comprises a joint picture experts group file.
45. The program product of claim 14 wherein the prioritized graphics file comprises a graphics interchange format file.
46. The program product of claim 14 wherein the prioritized graphics file comprises a bitmap file.
47. The method of claim 31 wherein the prioritized graphics file comprises a joint picture experts group file.
48. The method of claim 31 wherein the prioritized graphics file comprises a graphics interchange format file.
49. The method of claim 31 wherein the prioritized graphics file comprises a bitmap file.